

Appl. No. 10/082,957
Amdt. Dated September 24, 2004
Reply to Office action of March 24, 2004

REMARKS

The present amendment is being filed under a Certificate of Mailing as indicated. An appropriate Petition for Extension of Time accompanies this Amendment and is also filed under a Certificate of Mail.

The specification has been objected to because of informalities in that in the paragraph of the specification beginning on page 13, line 24, the number "74" should be "72." The paragraph of the specification beginning on page 13, line 24, has been amended to change the number "74" to the number "72." A replacement paragraph has been provided.

The objection to the specification because of informalities is now believed to be overcome. The removal of the objection to the specification because of informalities is hereby respectfully requested.

Claims 21-23, 25-26, 28, 30, 32-33 and 35-38 were rejected under 35 USC §102(b) as being anticipated by U.S. Patent 5,925,077 to Williamson et al.

Referring first to the rejection to claims 21-23 and 25-26, claim 21 has been amended to provide "said cup having a body

defining opposed, spaced apart concave and convex surfaces defining a first thickness therebetween, said cup including a portion thereof integral with said body." The plugs 18 in U.S. Patent 5,925,077 are separate components and are not integral with the acetabular shell component 12, as claimed in claim 21, as amended.

Claim 21, as amended, is thus, not anticipated by U.S. Patent 5,925,077. The rejection to claim 21 as being anticipated by U.S. Patent 5,925,077 is thereby believed to be overcome.

Claims 22-23 and 25-26 are dependent on newly amended claim 21, and are thus believed to be allowable over U.S. Patent 5,925,077.

Reconsideration of the rejection under 35 USC §102b to claims 21-23 and 25-26 as being anticipated by U.S. Patent 5,925,077 is respectfully requested.

Referring now to the rejection under 35 USC §102b to claims 28, 30, 32-33 and 35, claim 28 has been amended to provide "said cup having a body defining opposed, spaced apart concave and convex surfaces defining a first thickness therebetween, said cup including a portion thereof integral with said body." The plugs 18 in U.S. Patent 5,925,077 are separate components and are not

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integral with the acetabular shell component 12, as claimed in claim 21, as amended.

Claim 28, as amended, is thus, not anticipated by U.S. Patent 5,925,077. The rejection to claim 28 as being anticipated by U.S. Patent 5,925,077 is thereby believed to be overcome.

Claims 30, 32-33 and 35 are dependent on newly amended claim 28, and are thus believed to be allowable over U.S. Patent 5,925,077.

Reconsideration of the rejection under 35 USC §102b to claims 30, 32-33 and 35 as being anticipated by U.S. Patent 5,925,077 is respectfully requested.

Referring now to the rejection under 35 USC §102b to claim 36, claim 36 has been amended to include "providing an integral cup." The plugs 18 in U.S. Patent 5,925,077 are separate components and are not integral with the acetabular shell component 12, as claimed in claim 36, as amended.

Claim 36, as amended, is thus, not anticipated by U.S. Patent 5,925,077. The rejection to claim 36 as being anticipated by U.S. Patent 5,925,077 is thereby believed to be overcome.

Reconsideration of the rejection under 35 USC §102b to claim 36 as being anticipated by U.S. Patent 5,925,077 is respectfully requested.

Referring now to the rejection under 35 USC §102b to claims 37 and 38, claim 37 has been amended to include "an integral cup."

The plugs 18 in U.S. Patent 5,925,077 are separate components and are not integral with the acetabular shell component 12, as claimed in claim 38, as amended.

Claim 37, as amended, is thus, not anticipated by U.S. Patent 5,925,077. Claim 38 is dependent on newly amended claim 37, and is thus believed to be allowable over U.S. Patent 5,925,077.

The rejection to claims 37 and 38 as being anticipated by U.S. Patent 5,925,077 is thereby believed to be overcome.

Reconsideration of the rejection under 35 USC §102b to claims 37 and 38 as being anticipated by U.S. Patent 5,925,077 is respectfully requested.

Claims 21-40 were rejected under 35 USC §103(a) as being unpatentable over U.S. Patent 5,370,702 to Jones.

Referring first to the rejection under 35 USC §103(a) to claims 21-27, claim 21 has been amended to add the word "with a portable hand tool" to describe the mechanically separated

requirement of the portion. Jones does not teach or suggest the mechanically separated requirement of the portion of wall 16 to include "with a portable hand tool" as now claimed in the independent claim 21.

While the Examiner has correctly pointed out that Jones discloses that punching may be provided to remove portion 32, Jones does not teach or suggest a mechanically separated requirement of the portion "with a portable hand tool".

The Examiner has stated that the "applicant has not disclosed that a "substantially planar surface" solves any of the stated problems..."

The Applicants wish to direct the Examiner to the following statements from the Declaration filed on July 11, 2003:

"I believe that the use of a punch to remove the plugs from a hip cup with recesses is highly preferred in that a burr free hole may be provided quickly and easily. I have personally observed the use of a punch to remove the plugs by the testing of sample parts made using the design of the hole disclosed in this application. Burr free holes were quickly and easily made in these sample parts using a punch."

"I believe that the use of cup with the first bottom and the second bottom being substantially planar and spaced apart from each other as claimed in amended claim 15 of the application is beneficial in providing an easily punched cup."

Claim 21, as amended, is thus now patentable over U.S. Patent 5,370,702 to Jones. The rejection to claim 21 as being unpatentable over U.S. Patent 5,370,702 to Jones is thereby believed to be overcome. Claims 22-27 are dependent on newly amended claim 1 and are thus believed to be allowable over Jones.

Reconsideration of the rejection under 35 USC §103(a) to claims 21-27 as being unpatentable over Jones is respectfully requested.

Referring now to the rejection under 35 USC §103(a) to claims 28-35, claim 28 has been amended to add the word "with a portable hand tool" to describe the mechanically separated requirement of the portion. Jones does not teach or suggest the mechanically separated requirement of the portion of wall 16 to include "with a portable hand tool" as now claimed in the independent claim 28.

While the Examiner has correctly pointed out that Jones discloses that punching may be provided to remove portion 32,

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Jones does not teach or suggest a mechanically separated requirement of the portion "with a portable hand tool".

The Examiner has stated that the "applicant has not disclosed that a "substantially planar surface" solves any of the stated problems..."

The Applicants wish to direct the Examiner to the following statements from the Declaration filed on July 11, 2003:

"I believe that the use of a punch to remove the plugs from a hip cup with recesses is highly preferred in that a burr free hole may be provided quickly and easily. I have personally observed the use of a punch to remove the plugs by the testing of sample parts made using the design of the hole disclosed in this application. Burr free holes were quickly and easily made in these sample parts using a punch."

"I believe that the use of cup with the first bottom and the second bottom being substantially planar and spaced apart from each other as claimed in amended claim 15 of the application is beneficial in providing an easily punched cup."

Claim 28, as amended, is thus now patentable over U.S. Patent 5,370,702 to Jones. The rejection to claim 28 as being unpatentable over U.S. Patent 5,370,702 to Jones is thereby

believed to be overcome. Claims 29-35 are dependent on newly amended claim 28, and are thus believed to be allowable over Jones.

Reconsideration of the rejection under 35 §103(a) to claims 28-35 as being unpatentable over Jones is respectfully requested.

Referring now the rejection under 35 USC §103(a) to claim 36, claim 36 has been amended to add the word "with a portable hand tool" to describe how the punch is advanced. Jones does not teach or suggest that the punch is advanced on the portion of wall 16 "with a portable hand tool" as now claimed in the independent claim 36.

While the Examiner has correctly pointed out that Jones discloses that punching may be provided to remove portion 32, Jones does not teach or suggest that the punch is advanced "with a portable hand tool".

Claim 36, as amended, is thus now patentable over U.S. Patent 5,370,702 to Jones. The rejection to claim 36 as being unpatentable over U.S. Patent 5,370,702 to Jones is thereby believed to be overcome.

Reconsideration of the rejection under 35 §103(a) to claim 36 as being unpatentable over Jones is respectfully requested.

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Referring now the rejection under 35 USC §103(a) to claims 37 and 38, claim 37 has been amended to add the word "with a portable hand tool" to describe the mechanically separated requirement of the portion. Jones does not teach or suggest the mechanically separated requirement of the portion of wall 16 to include "with a portable hand tool" as now claimed in the independent claim 37.

While the Examiner has correctly pointed out that Jones discloses that punching may be provided to remove portion 32, Jones does not teach or suggest a mechanically separated requirement of the portion "with a portable hand tool".

The Examiner has stated that the "applicant has not disclosed that a "substantially planar surface" solves any of the stated problems..."

The Applicants wish to direct the Examiner to the following statements from the Declaration filed on July 11, 2003:

"I believe that the use of a punch to remove the plugs from a hip cup with recesses is highly preferred in that a burr free hole may be provided quickly and easily. I have personally observed the use of a punch to remove the plugs by the testing of sample parts made using the design of the hole disclosed in this

application. Burr free holes were quickly and easily made in these sample parts using a punch."

"I believe that the use of cup with the first bottom and the second bottom being substantially planar and spaced apart from each other as claimed in amended claim 15 of the application is beneficial in providing an easily punched cup."

Claim 37, as amended, is thus now patentable over U.S. Patent 5,370,702 to Jones. The rejection to claim 37 as being unpatentable over U.S. Patent 5,370,702 to Jones is thereby believed to be overcome. Claim 38 is dependent on newly amended claim 37, and is thus believed to be allowable over Jones.

Reconsideration of the rejection under 35 §103(a) to claims 37 and 38 as being unpatentable over Jones is respectfully requested.

Referring now the rejection under 35 USC §103(a) to claims 39 and 40, claim 39 has been amended to add the word "with a portable hand tool" to describe the mechanically separated requirement of the portion. Jones does not teach or suggest the mechanically separated requirement of the portion of wall 16 to include "with a portable hand tool" as now claimed in the independent claim 39.

While the Examiner has correctly pointed out that Jones discloses that punching may be provided to remove portion 32, Jones does not teach or suggest a mechanically separated requirement of the portion "with a portable hand tool".

The Examiner has stated that the "applicant has not disclosed that a "substantially planar surface" solves any of the stated problems..."

The Applicants wish to direct the Examiner to the following statements from the Declaration filed on July 11, 2003:

"I believe that the use of a punch to remove the plugs from a hip cup with recesses is highly preferred in that a burr free hole may be provided quickly and easily. I have personally observed the use of a punch to remove the plugs by the testing of sample parts made using the design of the hole disclosed in this application. Burr free holes were quickly and easily made in these sample parts using a punch."

"I believe that the use of cup with the first bottom and the second bottom being substantially planar and spaced apart from each other as claimed in amended claim 15 of the application is beneficial in providing an easily punched cup."

Claim 39, as amended, is thus now patentable over U.S. Patent 5,370,702 to Jones. The rejection to claim 39 as being unpatentable over U.S. Patent 5,370,702 to Jones is thereby believed to be overcome. Claim 40 is dependent on newly amended claim 39, and is thus believed to be allowable over Jones.

Reconsideration of the rejection under 35 §103(a) to claims 39 and 40 as being unpatentable over Jones is respectfully requested.

Claims 24 and 31 were rejected under 35 USC §103(a) as being unpatentable over U.S. Patent 5,925,077 to Williamson et al. in view of U.S. Patent 5,370,702 to Jones.

Referring first to the rejection under 35 USC §103(a) to Williamson in view of Jones to claim 24, claim 21 has been amended to add the word "with a portable hand tool" to describe the mechanically separated requirement of the portion. Neither Williamson or Jones, either individually or in combination, teach or suggest the mechanically separated requirement of the portion of wall 16 to include "with a portable hand tool" as now claimed in the independent claim 21.

While the Examiner has correctly pointed out that Jones discloses that punching may be provided to remove portion 32,

Jones does not teach or suggest a mechanically separated requirement of the portion "with a portable hand tool".

The Examiner has stated that the "applicant has not disclosed that a "substantially planar surface" solves any of the stated problems..."

The Applicants wish to direct the Examiner to the following statements from the Declaration filed on July 11, 2003:

"I believe that the use of a punch to remove the plugs from a hip cup with recesses is highly preferred in that a burr free hole may be provided quickly and easily. I have personally observed the use of a punch to remove the plugs by the testing of sample parts made using the design of the hole disclosed in this application. Burr free holes were quickly and easily made in these sample parts using a punch."

"I believe that the use of cup with the first bottom and the second bottom being substantially planar and spaced apart from each other as claimed in amended claim 15 of the application is beneficial in providing an easily punched cup."

Claim 24 which depends on claim 21, as amended, is thus now patentable over U.S. Patent 5,370,702 to Jones. The rejection to claim 24 under 35 USC §103(a) as being unpatentable over U.S.

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Patent 5,370,702 to Jones in view of U.S. Patent 5,925,077 to Williamson et al. is thereby believed to be overcome.

Reconsideration of the rejection under 35 §103(a) to claim 24 as being unpatentable Williamson et al. in view of Jones is respectfully requested.

Referring now the rejection under 35 USC §103(a) to Williamson in view of Jones to claim 31, claim 28 has been amended to add the word "with a portable hand tool" to describe the mechanically separated requirement of the portion. Neither Williamson or Jones, either individually or in combination, teach or suggest the mechanically separated requirement of the portion of wall 16 to include "with a portable hand tool" as now claimed in the independent claim 28.

While the Examiner has correctly pointed out that Jones discloses that punching may be provided to remove portion 32, Jones does not teach or suggest a mechanically separated requirement of the portion "with a portable hand tool".

The Examiner has stated that the "applicant has not disclosed that a "substantially planar surface" solves any of the stated problems..."

The Applicants wish to direct the Examiner to the following statements from the Declaration filed on July 11, 2003:

"I believe that the use of a punch to remove the plugs from a hip cup with recesses is highly preferred in that a burr free hole may be provided quickly and easily. I have personally observed the use of a punch to remove the plugs by the testing of sample parts made using the design of the hole disclosed in this application. Burr free holes were quickly and easily made in these sample parts using a punch."

"I believe that the use of cup with the first bottom and the second bottom being substantially planar and spaced apart from each other as claimed in amended claim 15 of the application is beneficial in providing an easily punched cup."

Claim 31 which depends on claim 28, as amended, is thus now patentable over U.S. Patent 5,370,702 to Jones. The rejection to claim 31 under 35 USC §103(a) as being unpatentable over U.S. Patent 5,370,702 to Jones in view of U.S. Patent 5,925,077 to Williamson et al. is thereby believed to be overcome.

Reconsideration of the rejection under 35 §103(a) to claim 31 as being unpatentable Williamson et al. in view of Jones is respectfully requested.

Further as the rejections to claims 24 and 31 under 35 USC §103(a) as being unpatentable over U.S. Patent 5,370,702 to Jones in view of U.S. Patent 5,925,077 to Williamson et al, the Federal Circuit has made it clear that a rejection under 35 U.S.C. § 103 is improper in the absence of a clear suggestion to combine the cited references. See, for example, In re Dembiczak, 50 USPQ 2d 1614, 1617-18, (Fed. Cir. 1999) wherein the Federal Circuit reversed a decision of the Board of Patent Appeals and Interferences rejecting as obvious claims to a plastic trash bag with a decorative pumpkin face:

All the obviousness rejections affirmed by the Board resulted from a combination of prior art references, e.g., the conventional trash or yard bags, and the Holiday and Shapiro publications teaching the construction of decorated paper bags. [citation omitted] To justify this combination, the Board simply stated that 'the Holiday and Shapiro references would have suggested the application of ... facial indicia in the prior art trash bags.' [citation omitted] However, rather than pointing to specific information in Holiday or Shapiro that suggest the combination with the conventional bags, the Board instead described in detail the similarities between the Holiday and Shapiro references and

the claimed invention, noting that one reference or the other-in combination with each other and the conventional trash bags-described all of the limitations of the pending claims. [citation omitted] Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the children's art references (Holiday an Shapiro) with the conventional trash or lawn bag references, nor does the Board make specific-or even inferential- findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis. [citation omitted]

To the contrary, the obviousness analysis in the Board's decision is limited to a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention. ... Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how Holiday and Shapiro references teach or suggest their combination with the conventional trash or lawn bags to yield the claimed invention. ... Because we do not discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art

references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand.

The same analysis applies here. Since there is no discernable motivation for combining the Williamson et al. and Jones references, the rejection of claims 1-9 under 35 U.S.C. § 103(a) cannot stand as a matter of law. Withdrawal of the rejection of claims 24 and 24 to Williamson et al. in view of Jones under 35 U.S.C. § 103(a) is respectfully requested.

A similarly broad conclusory statement was rejected by the Board of Patent Appeals and Interferences ("the Board") in the case entitled In re Kotzab, 217 F.3d 1365, 1369-70, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000). In that case, the examiner stated:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above references' teachings as taught by Sun et al., Lee et al., and Sandhu et al. because such use of planarized plugs by CMP [chemicalmechanical polishing] or etchback and the claimed deposition processes and materials are conventional and obvious as evidenced by Sun et al., Lee et al., and Sandhu et al. to enable the formation of a planarized plug for contact.

In reversing the examiner's rejection of the pertinent claims, the Board, in Ex Parte Huang, No. 1997-3338, (Bd. Pat. App & Int. 1997), relied upon the decision of In re Kotzab, 217 F.3d 1365, 1369-70, 55 U.S.P.Q2d 1313, 1316 (Fed. Cir. 2000), which stated:

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

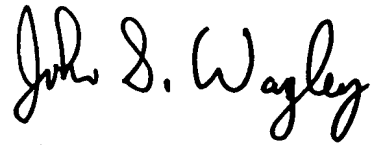
The Board then stated that "the examiner has not identified any motivation, suggestion or teaching of the desirability of combining Koyanagi or Scovell with Tsang, Shappir, Lee, Sun, and Sandhu to arrive at the appellants' claimed invention. Our reviewing court has made it clear that 'the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement

for a showing of the teaching or motivation to combine prior art references.'" Id. As a part of this requirement, the USPTO must provide particular findings as to the "identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis." See Dembiczak, 175 F.3d 994, 1000, 50 U.S.P.Q.2d 1614, 1617. Broad conclusory statements standing alone are not "evidence." Id. Based upon this ruling and the similarity of statements made by the examiner in Ex Parte Huang and the present case, the USPTO has clearly failed to meet its burden on showing the motivation to combine the references.

For the above-described reasons it is respectfully submitted that the rejections to the claims have been overcome and that claims 21-40 are currently in condition for allowance. Early Notice of Allowance is respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, reading "John S. Wagley". The signature is written in a cursive style with a large, stylized "J" and "W".

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